

REMARKS

Claims 1, 3-47, 49-80, 82-103 and 112-114 are pending and under consideration. Claims 13, 23-35, 56 and 89 are objected to and Claims 112 and 113 are allowed. Claims 1, 36, 40, 41, 47, 78, 96, and 114 have been amended.

Rejections Under 35 U.S.C. § 103

The Examiner rejected Claims 1, 3-12, 15-21, 41, 44-47, 49-56, 58-72, 78-80, 82-88, 91-98, 100-101 and 103 under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 6,336,860 to Webb (“Webb”) in view of U.S. Patent No. 6,609,978 to Paulsen, (“Paulsen”). Reconsideration of the rejection is requested in light of the amended independent claims.

The present invention discloses a gaming machine with two entirely separate games of chance, each with different sets of positions of play for different sets of game elements, or indicia. The player can win the second game of chance without obtaining a win in the primary, or first game of chance. Any prize achieved in the second game is awarded, again, irrespective of what happens in the first game. The second game of chance has the potential, on every play, for achieving a prize award. Thus, it is possible for the player to win both the first game of chance and the second game of chance on the first play, or just the second game. But whatever happens in the second game is independent of the first game outcome and the two games are displayed entirely independent of each other. Significantly, the present invention teaches that the secondary game of chance is a game in which a non-monetary prize can be achieved to differentiate it from the monetary-based primary game.

As the Examiner notes on page 9 of the Office Action, Webb teaches the display of game elements with multiple components of a color and symbol, and the evaluation of game elements according to a first set of criteria (symbols) and a second evaluation of game elements according

to a second set of criteria (color). Webb has payoffs for winning combinations determined by one game element criteria regardless of other game element criterion, (col. 6:49-67), not “a first game of chance with a first set of positions for a first set of game elements and a second game of chance on the same gaming machine which has a second set of positions for a second set of game elements, wherein said second set of positions is different than said first set of positions, and said second set of game elements is different than said first set of game elements” according to the present invention.

Webb simply does not have a first game of chance and an entirely separate and different second game of chance. Webb is the same game with each line of the matrix defining a “mode of play” (i.e., a single line, multi-line, etc.) of a single game of chance, as the specification recites at col. 8:33-35. See also col. 4:8-10 and col. 4:27-30. Each line of the matrix in Webb is not a separate game of chance, but a single game of chance with the lines selected from the matrix defining a mode of play. Webb only has one set of positions for play of one set (of multi-characteristic) symbols. The Examiner argues Webb “demonstrates two distinct game outcomes irrespective of each other” (Office Action, p. 10), but Webb teaches multiple game outcomes of the same game. Webb evaluates the single set of symbols with respect to the single set of positions of the same game.

Applicants’ invention keys on the distinctiveness of the two games, and their independence. The random numbers used to select from the first set of symbols for the first set of positions is independent of the random numbers used to select from the second set of symbols for the second set of positions. The non-monetary award of the second game heightens the differentiation. What the player sees is the ability to simultaneously play two very different

games, one non-monetary--not two ways to win the same game. Applicants' invention heightens the player's interest in the gaming machine in a new way.

Additionally, the Examiner argues Webb's preface of "numerous games and wagering opportunities can be provided ... and thereby establishes the equation of a game encompassing multiple sub-games", (Office Action, p. 10), which is precisely *not* the present invention. Furthermore, the Examiner suggests "multi-line wagering on a multi-line slot machine wherein each distinctive non-overlapping line represents a singular game of chance" (Office Action, p. 10), but the Examiner fails to consider that Webb is a matrix of numerous lines of the *same* game with varying payoffs and volatility. (Abstract; col. 8:39-40). Again, Webb is a matrix defining a "mode of play" (i.e., a single line, multi-line, etc.) of a single game of chance, further evidenced by the excerpt of Webb that discloses "each mode could allow ... the ability to retain favorable symbol combinations for a subsequent play" of the same game. (col. 2:26-29). Applicants do have a variant wherein the player has the ability to select certain cards in the first (primary) game, and thereby also get a potential new replacement prize indicium in the second game for the respective discard (e.g., claim 13). The second game still operates independently however. The Examiner has already recognized the patentability of these claims (e.g., 13, 56, 89 and 113).

Webb discloses embodiments of the invention as a method of playing a game of chance. (col. 2:35-37; Claims 1, 18, 35, 36, 37). Webb fails to teach or suggest a "first game of chance" and a "second game of chance" altogether. Furthermore, Webb does not disclose "a first game of chance with a first set of positions for a first set of game elements and a second game of chance on the same gaming machine which has a second set of positions for a second set of game elements, wherein said second set of positions is different than said first set of positions, and said second set of game elements is different than said first set of game elements". More so, Webb

does not disclose operating the second game of chance “irrespective of any result occurring in a first game of chance” claimed by the present invention because there is quite simply only one game of chance in Webb. Moreover, as the Examiner notes, “Webb lacks the explicit teaching of the prize being non-monetary.” (Office Action, p. 3).

Paulsen does not satisfy the deficiencies of Webb because there is no teaching, suggestion, or motivation to combine these references. The Examiner argues “there is no cited or otherwise provided reference within the Webb reference that would teach away from the utilization of a non-monetary prize.” (Office Action, p. 11). Although, “a reference will teach away if it suggests that the line of development flowing from the reference's disclosures is unlikely to be productive of the result sought by the applicant.” *See In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

Applicants have further amended claims 1, 36, 40, 41, 47, 78, 96, and 114 to drive the distinction home that the games are separate and distinct from each other, even as to the sets of positions on the display thereof on the gaming machine. Thus, regardless of what Paulsen shows in the way of a non-monetary award, there is nothing suggesting the unique combination of two such disparate games on one machine in the manner of the newly-amended claims.

Webb actually teaches away from Paulsen. Webb discloses that a player is awarded credits according to the payout schedule for the game. (col. 4: 33-35). In addition, Webb discloses payouts that vary with rank, color or shape of the symbols of a winning combination. (col. 2: 65-67; col. 8: 5-12 and col. 8: 38-40). “Credits” and “varying payouts” implicate a monetary award. The varying payouts disclosed in Webb teach away from the non-monetary award of Paulsen. After all, how can one vary a non-monetary award? Thus, this teaches away from the non-monetary award of Paulsen.

Although the references need not expressly teach that the disclosure contained therein should be combined with another, the showing of “combinability” must be “clear and particular.” *Ruiz v. A.B. Change Co.*, 234 F.2d 654, 665 (Fed. Cir. 2000). In other words, there must be some teaching or suggestion to “look to particular sources, to select particular elements, and to combine them as combined by the inventor.” *Crown Operations Int'l, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 1376 (Fed. Cir. 2002). The line of development flowing from the Webb and Paulsen disclosures is unlikely to be productive of the result sought by the Applicants. *See In re Gurley*, 27 F.3d at 553.

Independent Claims 1, 41, 47, 78 and 96 clearly recite a first game of chance concluding to a monetary prize award, a second game of chance concluding to a non-monetary prize award, and a first game of chance with a first set of positions for a first set of game elements and a second game of chance on the same gaming machine which has a second set of positions for a second set of game elements, wherein said second set of positions is different than said first set of positions, and said second set of game elements is different than said first set of game elements, all of which Webb fails to teach or suggest. Moreover, Paulsen fails to fulfill the deficiencies of Webb as there is no motivation to combine these references to teach or suggest independent claims 1, 41, 47, 78 and 96. Since Applicants’ independent claims are in condition for allowance, all dependent claims thereon are also in condition for allowance.

The Examiner’s rejection of Claim 102 under 35 U.S.C. §103 as being unpatentable over Webb in view of Paulsen, in further view of U.S. Patent No. 6,468,156 to Hughes-Baird et al., (“Hughes-Baird”) is moot in light of the arguments above. Dependent Claim 102 plainly contains all of the limitations of independent Claim 96. As distinguished above, independent

Claim 96 is not obvious in view of any combination of the cited references. Since Claim 96 is in condition for allowance, all dependent claims thereon are also in condition for allowance.

The Examiner rejected Claims 14, 36-39, 57, 73-77, 90, 99 and 114 under 35 U.S.C. §103 as being unpatentable over Webb in view of Paulsen, in further view of U.S. Patent No. 6,311,976 to Yoseloff et al., (“Yoseloff”). Reconsideration of the rejection is requested in light of the amended independent claims.

Yoseloff does not fulfill the deficiencies of Webb and Paulsen, described and distinguished above. Yoseloff does not teach “a first game of chance with a first set of positions for a first set of game elements and a second game of chance on the same gaming machine which has a second set of positions for a second set of game elements, wherein said second set of positions is different than said first set of positions, and said second set of game elements is different than said first set of game elements”. Yoseloff discloses a wagering game with a first game segment and a second game segment that are operated separately. The second game segment of Yoseloff is “a bonus event or jackpot event” (col. 7:53-55). The second game segment is initiated upon a predetermined triggering event such as the appearance of three similar symbols on the reel (col. 11:66 – col. 12:2). The second game segment may not be played at all if the triggering event does not occur in the first segment (col. 12:3-5). Thus, in contrast to Applicants foregoing Claims, Yoseloff does not teach playing the second game segment on the same gaming machine irrespective of any result occurring in the first game segment since, in Yoseloff, three similar symbols in the first game segment initiates the bonus event.

Independent Claims 36 and 114 and dependent Claims 14, 37-39, 57, 73-77, 90, and 99 all include the limitations that the second game of chance is operated during the first game of chance and irrespective of any result occurring in the first game, playing both games of chance on

the same gaming machine, but with a first set of positions for a first set of game elements and a second set of positions for a second set of game elements, wherein said second set of positions is different than said first set of positions, and said second set of game elements is different than said first set of game elements distinguishing Applicants' invention over the cited references. As distinguished above, *supra*, independent Claims 1, 36, 47, 78 and 96 are not obvious in view of any combination of the cited references. Since Applicants' independent claims are in condition for allowance, all dependent claims thereon are also in condition for allowance.

The Examiner rejected Claims 22, 40 and 42-43 under 35 U.S.C. §103 as being unpatentable over Webb in view of Paulsen, in further view of U.S. Patent No. 6,685,563 to Meekins et al., ("Meekins"). Reconsideration of the rejection is requested in light of the amended independent claims.

Meekins does not fulfill the deficiencies of Webb and Paulsen, described and distinguished above. Meekins does not teach operating a first game of chance with a first set of positions for a first set of game elements and a second game of chance with a second set of positions for a second set of game elements, wherein said second set of positions is different than said first set of positions, and said second set of game elements is different than said first set of game elements, and playing said second game irrespective of any result occurring in the first game. Meekins is a method of operating a wagering game with a base unit and bonus unit (col. 2:45-55). The base unit is played wherein a winning payout increases the player's credits on a credit meter or payout through a coin exit chute (col. 4:42-45). The bonus game initiates when the coin or credit threshold exceeds a predetermined value (col. 4:42-45). The bonus game is dependent on the result occurring in the base game (col. 4:63-64; col. 6:30-34). A winning condition in the base game increases the player's coins or credits which in turn advances the

player to the predetermined threshold value required for playing the bonus game (col. 6:30-34). Moreover, Meekins fails to teach a “first game of chance” and a “second game of chance” that are operated “in conjunction.”

In contrast to Applicants foregoing Claims, Meekins does not teach each and every limitation of independent Claims 1, 40 and 41. As distinguished above, independent Claims 1, 40 and 41 are not obvious in view of any combination of the cited references. In addition, dependent Claims 22 and 42-43 contain further limitations that the cited prior art raised in rejection does not teach or suggest as a whole. Since independent Claims 1, 40 and 41 are in condition for allowance, all dependent claims thereon are also in condition for allowance.

Allowable Subject Matter

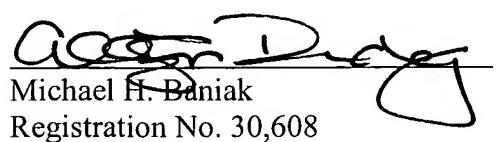
Applicants acknowledge the allowability of Claims 112-113. In addition, Applicants acknowledge the objection to Claims 13, 23-35, 56 and 89 as being dependent upon a rejected base claim, but allowable if rewritten in independent form. Applicants suggest however, in view of this Response, that these Claims should be allowable without the need for a re-write. The Applicants respectfully request reconsideration of the Examiner’s objections.

Allowance of this application is respectfully requested.

Respectfully submitted,

March 1, 2006

BANIAK PINE & GANNON
150 N. Wacker Drive, Suite 1200
Chicago, Illinois 60606
(312) 673-0360
(312) 673-0361 facsimile


Michael H. Baniak
Registration No. 30,608
Allison M. Dudley
Registration No. 50,545
Attorneys for Applicants